

## **REMARKS**

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1-10 are now present in this application. Claim 1 is independent. Reconsideration of this application is respectfully requested.

### **Drawings**

Applicant acknowledges with appreciation the indication in the Office Action that Applicant's drawings are accepted.

### **Rejections under 35 U.S.C. §103**

Claims 1-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Applicant's disclosed conventional art in Figs. 5 and 6 in view of U.S. Patent No. 6,275,220 to Nitta. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action and is not being repeated here.

As previously indicated in Applicant's Amendment filed February 18, 2004, Applicant notes that no admission has been made that the drawing shown in Fig. 5 is prior art.

In that Amendment, Applicant requested that the Examiner provide evidence that the drawing shown in Fig. 5 is prior art in the next Office Action.

Otherwise, the Applicant requests that the Applicant's disclosure (particularly Fig. 5) be withdrawn as a prior art reference.

Unfortunately, no such evidence has been provided. The outstanding Office Action does not even address this issue despite the fact that the MPEP requires that an Office Action answer each issue raised in Applicant's response. See MPEP §707.07(f), which clearly states that, where the applicant traverses any rejection, the Examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

Applicant respectfully submits that this failure to treat this ground of traversal denies Applicant fundamental substantive and procedural due process to which Applicant is entitled under the Administrative Procedures Act. See, In re Zurko, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999) and In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

Accordingly, this rejection is fundamentally unsound and must be withdrawn.

Nevertheless, in order to be completely responsive to the outstanding Office Action, Applicants provide the following remarks.

Applicant has not admitted that Figures 5 and 6 are prior art to Applicant. In Eleming v. Giesa (BdPatApp&Int) 13 USPQ2d 1052 (7/17/1989) it was held that for an admission to be used against a party, it must be clear, unequivocal and unmistakable. See also, Harner et al. v. Barron et al., 215

USPQ 743 (Comr Pats 1981), Suh v. Hoefle (BdPatApp&Int) 23 USPQ2d 1321 (4/30/1991), Issidorides v. Ley (BdPatApp&Int) 4 USPQ2d 1854 (4/2/1985) and Ex parte The Successor In Interest Of Robert S. McGaughey (BdPatApp&Int) 6 USPQ2d 1334 (3/4/1988).

All that Applicant has done is to refer to Figs. 5 and 6 as "Conventional Art." Something can be conventional art in the sense that it is practiced in the real world at the time of Applicant's filing of this Application but may not be prior art to Applicant in any sense, including, for example, under 35 U.S.C. §103, which forms the basis for this rejection. See, in this regard, the relatively recent amendments to 35 U.S.C. §103(c).

Under the circumstances, i.e., where Applicant merely describes Figs. 5 and 6 as conventional art, the Office Action has not established that Applicant has made a clear, unequivocal and unmistakable admission on the record that what is disclosed in Figs. 5 and 6 is prior art to Applicant. In this regard, the Examiner is also advised that the initial burden to establish something as prior art is on the Office as part of its burden of making out a *prima facie* case of unpatentability.

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444(Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788(Fed. Cir. 1984). If the PTO fails to meet this burden,

then the applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the applicant to come forward to rebut such a case.

Applicant respectfully submits that the Office has not made out a *prima facie* case of unpatentability at least because it has not made out a *prima facie* case that Figs. 5 and 6 are prior art to Applicant.

Moreover, because Figs. 5 and 6 form the primary applied reference in this rejection, and because they have not been established to be prior art, the rejection is wholly improper and should be withdrawn.

In order to be fully responsive to this rejection, Applicants will also present arguments directed to why, even if Figs. 5 and 6 were prior art, which they have not been established to be, that the claimed invention is not obvious over that subject matter in view of Nitta.

It is well settled that a rejection based on 35 U.S.C. §103 must rest on a factual basis, which the Patent and Trademark Office has the initial duty of supplying. *In re GPAC, Inc.*, 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995); *In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

In so doing, the Examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966) and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references

to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F. Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness

holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232(Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

The Office Action’s statement of the difference between claim 1 and Figs. 5 and 6’s conventional art does not describe all of the differences between them. For example, in Fig. 5, the output pads of both driving circuit structures 6 and 7 are located on the underside of the driving circuit structures 6 and 7, and the TCP pads are located under the driving circuit structures 6 and 7 to connect with those driving pads. On the other hand, Nitta does not have separate driving circuit electrode structure as does Fig. 5, nor does Nitta have output pads at all, let alone output pads located on the underside of a separate driving structure. Nitta merely has a plurality of electrodes 14 (see col. 2, lines 45-49) to which the TCP pads are directly connected, and the connection is not on the underside of anything.

The Office Action alleges that it would be obvious to incorporate the tape carrier packages connecting the driving circuit boards and the electroluminescence panel in a planar state as taught by Nitta in the system of conventional art Figs. 5 and 6 “in order to provide a display that is capable of being made having a small thickness.”

Applicant respectfully submits that there is no teaching in either Figs. 5 and 6 or in Nitta of the existence of a problem that requires a display having a smaller thickness than that shown in Figs. 5 and 6. The only disclosure of the problem solved by Applicant's invention is in Applicant's disclosure, which cannot properly be used against Applicant, such a use being improper hindsight reconstruction of the claimed invention based solely on Applicant's disclosure.

Moreover, Nitta does not indicate that its TCP configuration solves a space problem, nor does Nitta disclose driving circuit boards located within the panel.

Furthermore, the Office Action never mentions what incentive one of ordinary skill in the art would have to change Figs. 5 and 6's output pads of driving circuit structures so that they are at the top of those structures instead of at the bottom of those structures.

As stated above, the reason to motivate a skilled worker to modify one reference in view of another must be clear and particular and not be based, as it is here, on the fact that both Figs. 5 and 6 and Nitta disclose displays utilizing tape carrier packages.

Additionally, an analysis of Nitta reveals that Nitta differs substantially from the claimed invention and from Applicant's disclosed conventional (but not prior) art. For example, Nitta's "extending portion 15a" – see col. 2, line 33,

of plate 15 is used to install its printed wiring board (PWB or PCB) 18. Applicant's invention does not need an extended portion, such as Nitta's extended portion 15a, as does Nitta.

The side of Nitta's display area that is labeled, in Fig. 2, as "LIGHT EMITTING FACE", does not correspond to Applicant's light emitting face. Applicant's light emitting face is not the face on which the electrodes and PCB's are installed – see Applicant's Fig. 7 in this regard.

For example, referring to Fig. 8 of Applicant's invention, element 62 corresponds to element 22b of Fig. 2 of Nitta, Applicant's element 54 corresponds to element 18 of Nitta, and Applicant's element 50 corresponds to elements 11 and 12 of Nitta.

Because the light-emitting face of Applicant's invention is not the same as the light emitting face of Nitta, one can see that Nitta's extended non-display area 15a used to attach Nitta's PCB 18 is not needed by Applicant's invention. In other words, Nitta's rear face is its light emitting face, i.e., the same face on which its IC's and PCB's are attached, whereas in Applicant's device, the TCP's and FPB's are attached to the plate through which light is not emitted. Light is emitted in Applicant's invention through the opposite face from the face on which the TCP's and FPB's are located.

To reduce the extended non-display area using TCP's or FPB's, the conventional (but not prior art) technology in Applicant's Specification



connects the PCB with the display panel using TCP or FPB which is bent to dispose the PCB on the rear side of the display panel. In such a case, the wire is susceptible to opening or breakage at the bent portion, even though the TCP or FBO is made of flexible material, as disclosed in Applicant's specification.

Applicant's claimed invention reduces the extended non-display area as well as to eliminate potential breakage and opening of a TCP or FPB.

Moreover, as pointed out in a previous response, the panel 10 of Nitta is installed on a reinforcing plate 15. The reinforcing plate 15 has an extended part, on which a flexible printed wired board and a TAB is disposed. Clearly, in Nitta, the flexible printed wired board is positioned outside the panel.

By contrast, in the Applicant's claimed invention, the TCP and the driving circuit boards are positioned within the panel.

The only teaching of a TCP located within the panel is in Figs. 5 and 6, which has not been established to be prior art to Applicant.

Accordingly this rejection of claims 1-10, all of which recite the features discussed above, is improper and should be withdrawn.

### **Conclusion**

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be

withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

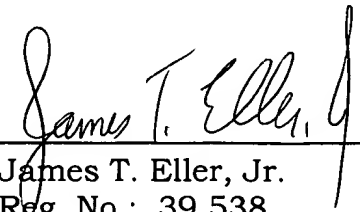
If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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